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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,625	05/02/2001	Luis A. Rovira	A-6671	5607

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SCIENTIFIC-ATLANTA, INC.  
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EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2617

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/847,625

Applicant(s)

ROVIRA, LUIS A.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

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### *Response to Arguments*

1. Applicant's arguments with respect to Claims 1-25 and 27-36 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7-10, 18-20, 22, 25, 27, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by *Lett et al.* (US Pat. No. 5,592,551).

As to claim 1, *Lett et al* disclose a system which displays an IPG having current and future scheduled programming, with said future scheduled programming being offered in advance of said future scheduled time. (Abstract; Col. 2, Ln. 64-Col. 3, Ln. 17; Fig. 16). For example, Figure 16 shows the “Terminator 2” being currently scheduled and scheduled for a future time. If the user does not want to wait until the 10 pm “later time” to view the future scheduled “Terminator 2,” he or she can receive the program at the current scheduled time of 6:30. Therefore, the system provides the user with said future program prior to said later time as recited in Claim 1. Accordingly, *Lett et al* anticipate each and every limitation of Claim 1.

Claims 19 and 36 are encompassed by Claim 1. Thus, each is analyzed and rejected as previously discussed.

As to Claim 2, *Lett* further discloses a system which requires a user to enter a security number (i.e., used to confirm the user is authorized). (Col. 2, Ln. 1-6). Accordingly, *Lett et al* anticipate each and every limitation of Claim 2.

Claim 22 corresponds to Claim 2. Thus, it is analyzed and rejected as previously discussed.

As to Claim 3, *Lett* further discloses charging a user a fee in connection with the provision of programs. (Col. 1, Ln. 32-42 and cited portions used to reject Claim 1). Accordingly, each and every limitation of Claim 3 has been anticipated by *Lett*.

Claim 20 corresponds to Claim 3. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, *Lett* further discloses an IPG which lists information pertaining to program titles, times, and channels. (Fig. 5). Accordingly, each and every limitation of claim 7 has been anticipated by *Lett*.

Claim 25 corresponds to Claim 7. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, *Lett* further discloses an IPG, which utilizes a remote control device in order to display program information and to display the later schedule programs. (Col. 11, Ln. 13-15). Accordingly, each and every element of claim 8 has been anticipated by *Lett*.

As to Claims 9 and 10, *Lett* further discloses receiving programming from a headend and content provider, respectively. (Fig. 1). Accordingly, *Lett et al* anticipate each and every limitation of Claims 9 and 10.

Claim 27 corresponds to Claim 9. Thus, it is analyzed and rejected as previously discussed.

As to claim 18, *Lett* further discloses an IPG, which provides a user with access to current television programs (disclosed under Claim 1). Accordingly, each and every limitation of claim 18 has been anticipated by *Lett*.

Claim 35 corresponds to Claim 18. Thus, it is analyzed and rejected as previously discussed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lett et al*.

Applicant's claim 4 recites the method of Claim 1, further comprising a method of charging a user a fee in connection with providing access to future programs. As discussed in paragraph 5 above, *Lett et al* disclose a method of charging a user a fee in connection with the "provision" of a later scheduled program, but fails to teach a method of charging said user a fee

in connection with providing “access” to said programs. However, it would have been obvious to one ordinarily skilled in this art at the time of applicant’s invention to modify the billing method of *Lett* to also include charging the user for having “access” to the future television programming. Charging a fee for access to a program is an obvious variant of charging a fee for the provision of the program, thereby allowing the content provider an additional avenue of charging a user.

Claim 21 is an apparatus claim corresponding to the method claim 4, and is analyzed and rejected as previously discussed.

4. Claims 5, 6, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lett* in view of Matthews, III (US #5815145).

Applicant’s claim 5 recites the method of Claim 1, and further discloses an IPG which contains a table corresponding to individual episodes of a given future television program. As discussed above, *Lett* discloses all limitations of claim 1, but fails to disclose an IPG containing an episode database. Within the same field of endeavor, Matthews, III, discloses an IPG database containing episodes corresponding to television programs. (Col. 7, Ln 48-49). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant’s invention to combine the IPG of *Lett* with the episode database of Matthews III in order to provide a more detailed and extensive program list for the user to choose from.

Claim 23 is an apparatus claim corresponding to the method claim 5, and is analyzed and rejected as previously discussed.

As to claim 6, *Lett* further discloses that the programs listed in the IPG could be sit-coms or dramas, but fails to specifically list whether programs could be soap-operas. (Fig. 5). However, claim 6 recites a Markush Group, which is anticipated if it is shown that one alternative is contained within the prior art. Accordingly, each and every limitation of claim 6 has been anticipated by *Lett*. (Moreover, the examiner would like to note that soap operas are considered to be an obvious variant of a sit-com or drama, which were combined to provide a more exhaustive listing and could also be rejected accordingly.)

Claim 24 is an apparatus claim corresponding to method claim 6, and is analyzed and rejected as previously discussed.

5. Claims 11, 12, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lett et al* in view of *Ellis*. (WO 99/60790).

Claim 11 recites the method of Claim 1, wherein said further television program is stored in a memory located inside said client device. As discussed above, *Lett et al* anticipate each and every limitation of Claim 1, but fail to specifically recite the limitations of Claim 11. However, within the same field of endeavor, *Ellis* discloses a similar system which stores a video on demand program within a home storage device (page 24, Ln. 4-9). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Lett* and *Ellis* in order to provide a system which allows a user to conveniently store his or her desired programs.

Claim 28 corresponds to Claim 11. Thus, it is analyzed and rejected as previously discussed.

As to claim 12, *Ellis* further discloses an IPG system, which stores programs in devices capable of being connected, i.e., coupled, to a set-top box, i.e. client device. (Page 15, Ln. 28-32). Accordingly, the combined systems of *Lett* and *Ellis* disclose all limitations of Claim 12.

Claim 29 corresponds to Claim 12. Thus, it is analyzed and rejected as previously discussed.

6. Claims 13, 14, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lett* in view of *Ganek et al.* (US #5,682,597).

Applicant's claims 13 and 14 recite methods of storing said television programs in either a hub or node, respectively. As discussed above, *Lett* anticipates each and every limitation of applicant's claim 1, but fails to specifically state whether programs can be stored in hubs or nodes. Within the same field of endeavor, *Ganek* teaches the use of hubs and nodes, which are used to store video programs. (Col. 1, Ln. 65-68). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of *Lett* with the hub and node storage teaching of *Ganek* in order to provide a more bandwidth efficient method of storage.

Claims 30 and 31 are apparatus claims corresponding to method claims 13 and 14, respectively. Accordingly, they are analyzed and rejected as previously discussed.

7. Claims 15, 16, 17, 32, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lett* in view of *Girard et al.* (US # 5,751,282).



Applicant's claim 15 recites the method of claim 1, wherein the future program is stored in a device located inside a cable television system. As discussed above in paragraph 5, *Lett* anticipates each and every limitation of applicant's claim 1, but fails to specifically disclose whether a storage device is located inside a cable television system. Within the same field of endeavor, *Girard* discloses a program storage device, which is contained within a cable television system. (Fig. 1). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of *Lett* with the storage device of *Girard* in order to provide an alternative method of storing said future programs.

Claim 32 is an apparatus claim corresponding to the method claim 15, and is analyzed and rejected as previously discussed.

Applicant's claim 16 recites a method of claim 1, wherein the future program is stored in a device coupled to a cable television system. As discussed above, *Lett* anticipates each and every limitation of applicant's claim 1, but fails to specifically state whether a storage device is coupled to a television system. Within the same of field of endeavor, *Girard* discloses that the program storage device is contained within or, i.e., coupled to, a cable television system. (Fig. 1). Accordingly, the combined systems of *Lett* and *Girard* disclose all limitations of Claim 16.

Claim 33 corresponds to Claim 16. Thus, it is analyzed and rejected as previously discussed.

Applicant's claim 17 recites the method of claim 1 wherein the user is provided with access to previously broadcasted television programs. As discuss above, *Lett* anticipates each and every limitation of applicant's claim 1, but fails to specifically discuss providing access to previously broadcasted television programs. Within the same field of endeavor, *Girard* teaches

the user's access to previously broadcasted television programs. (Col. 2, Ln. 19-21 & 30-32). Accordingly, the combined systems of *Lett* and *Girard* disclose all limitations of Claim 17.

Claim 34 corresponds to Claim 17. Accordingly, it is analyzed and rejected as previously discussed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
September 20, 2005.



VIVEK SRIVASTAVA  
PRIMARY EXAMINER